

REMARKS/ARGUMENTS

Claims 42-74 were pending in the application. Claims 52-56 have been withdrawn as being drawn to a non-elected invention. Claim 47 has been amended to depend from claim 42. New claims 75-80 have been added. Claims 42-80 are currently pending

Support for the new Claims 75-80 is replete in the application as filed. For example, support for Claims 75 – 77 can be found in the specification, *e.g.*, pages 45-46, paragraph [095]-[096]. Support for Claims 78 and 79 can be found in the specification at page 26, paragraph [058]. Support for claim 80 can be found in the specification at page 52, paragraph [0106].

Applicants hereby elect Group I, claims 42-46 and 57-74 drawn to a small interfering RNA (siRNA) comprising 15-25 nucleotide complementary to a target nucleic acid sequence wherein the RNA comprises at least one internucleoside linkage chosen from ribo-N3'→P5' phosphoramidate (NP) and ribo N3'→P5' thiophosphoramidate (NPS) linkages classifiable in class 536, subclass 24.5, for examination on the merits.

Applicants traverse the restriction between Groups I and II on the basis of the present claim amendments. Applicant has amended claims 47 - 51 to depend from claim 42. The Restriction Requirement stated that claims 47 – 51 belonged to Group II on the basis that the invention of Groups I and II were unrelated because Group I was directed to siRNA and Group II was directed to a compound of a particular structure. However, Applicant has now amended claim 47 to depend from claim 42 and to incorporate all of the limitations of claim 42. Accordingly, Applicants traverse the restriction between Group I and Group II.

Applicant has added new Claims 75-80. Applicant believes that Claims 42-51 and 57-80 fall within the subject matter of Group I, as set forth in the pending restriction requirement.

The Examiner indicated that if Group I was elected claims 63, 65, 67, 69, 71 and 73 are subject to an additional restriction since it is not considered to be a proper genus/Markush. The Office specifically states that this is a restriction and not an election of species and does not indicate that claim 42 is a linking claim and provide for the possibility of rejoinder.

Applicants specifically traverse this restriction on the basis that the claims are a proper genus. The invention is directed to the discovery that an siRNA can include at least one internucleoside linkage chosen from ribo-N3'→P5' phosphoramidate (NP) and ribo N3'→P5' thiophosphoramidate (NPS) linkages. Such siRNAs can be used for effecting post-transcriptional silencing of a gene. Accordingly, the members of the Markush group possess properties in common and it is clear that all of them possess this property. It is improper for the Office to refuse to examine that which Applicants regard as their invention. The members of the group are sufficiently similar that a search and examination of the entire claim can be made without a serious burden to the Examiner. See MPEP 803.02. Broadly unity of invention exists where compounds included with a Markush group share a common utility and share a substantial structure feature essential to that utility.

MPEP 803.02 states that where the members of a Markush group are so unrelated and diverse, the examiner may require a provisional election of a single species prior to examination on the merits. Following election of the species, the Markush-type claim should be examined fully with respect to the elected species and further to the extent necessary to determine patentability. The Examiner has requested an improper restriction rather than an election of species. Withdrawal of the restriction requirement is respectfully requested.

Should the Examiner maintain that the restriction is proper, MPEP 809 states that where a restriction of the claims is proper but presented in the same case are one or more claims (generally called "linking" claims) which if allowable would require joinder of the otherwise divisible invention, the linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn. Any claims directed to the nonelected invention previously withdrawn from consideration which depends from or requires all the limitations of the allowable linking claim must be rejoined and fully examined for patentability. Applicants maintain that should the restriction be proper, (which Applicants maintain is incorrect) claim 42 is a linking claim and rejoinder of claims 63-74 should be allowed upon allowance of claim 42.

Reply to Restriction Requirement of June 18, 2009

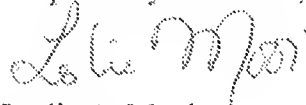
In complete response to the restriction requirement, Applicants elect the group of claim 63, the HIV gene.

The Office indicates that it has required restriction between product and process claims. Applicant has elected claims directed to the product. Should a product claim subsequently be found to be allowable, withdrawn process claims that depend from or otherwise include all of the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-566-7106.

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Respectfully submitted,



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